

### **REMARKS**

Claims 1 through 10, 14 through 19 and 22 through 42 are pending in the application. Claims 11 through 13 and 20 have been canceled, Claims 14, 15, 21 and 25 through 27 have been amended and Claims 28 through 42 are newly presented. Bases for the amendments and support for the new claims may be found throughout the application, claims and drawings as originally filed and as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the objections and rejections in view of the amendments and remarks contained herein.

### **DRAWINGS**

The drawings stand objected to under 37 CFR 1.83(a). More specifically, the Office has stated that the drawings do not show a first stop and a second stop as recited in Claim 1 and 11. The objection is respectfully traversed.

Applicant notes that Claim 1 recites a "height setting device" and Claim 11 recites a "setting device", both of which including a "first stop", which is coupled to one of the base and the carriage, and a "second stop", which is coupled to the other one of the base and the carriage. Applicant notes that in the example of Figure 19, the carriage height setting mechanism (20), which is a type of height setting mechanism, includes a stop adjustment assembly (900) that is coupled to the carriage and a stop member (902) that is coupled to the base. Accordingly, Applicant submits that a "first stop" and a "second stop" are illustrated in the drawings and respectfully requests that the Examiner reconsider and withdraw the objection to the drawings under 37 C.F.R. 1.83(a).

## **REJECTION UNDER 35 U.S.C. § 112**

Claims 1 through 10, 15 through 19 and 22 through 27 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Office contends that the specification does not provide antecedent bases for the following terms: a) height setting device; b) first stop; c) second stop; d) adjustment portion; and e) pivot point. Additionally, the Office contends that the specification fails to provide support for "... the second stop being coupled to the other one of the base and the carriage assembly, the second stop including an adjustment portion". With regard to the latter basis of rejection, the Office notes that Claims 1 and 15 "imply that the 'adjustment portion' can be affixed to either the base or the carriage, however the specification fails to provide support for two such embodiments." These rejections are respectfully traversed.

Applicant respectfully submits that one of ordinary skill in the art would readily discern from Applicant's originally filed disclosure the following:

- a) carriage height setting mechanism (20) is a type of "height setting device";
- b) stop member (902) may be one of the first and second stops, depending on the language of the particular claim;
- c) stop adjustment assembly (900) may be the other one of the first and second stops depending on the language of the particular claim;
- d) rotary selector knob (906) is a type of "adjustment portion"; and
- e) rotary axis (938) defines a pivot point about which an adjustment portion (e.g., the rotary selector knob (906)) rotates.

Accordingly, Applicant submits that the specification does provide antecedent basis for the above-referenced terms and thus describes the invention in a way as to enable one skilled in the art to which it pertains to make and/or use the invention. As such, Applicant

respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 1 through 10, 15 through 19 and 22 through 27 under 35 U.S.C. §112, first paragraph.

With regard to the coupling of the adjustment portion to either the base or the carriage, Applicant notes that the Examiner is correct in that the adjustment portion may be coupled to the base (in which case the first stop is coupled to the carriage) or to the carriage (in which case the first stop is coupled to the base). Applicant notes, too, that while only the latter condition is illustrated in the figures, the "Detailed Description" portion of the present application concludes by stating:

While the invention has been described in the specification and illustrated in the drawings with reference to a preferred embodiment, it will be understood by those skilled in the art that various changes may be made and equivalents may be substituted for elements thereof without departing from the scope of the invention as defined in the claims. In addition, many modifications may be made to adapt a particular situation or material to the teachings of the invention without departing from the essential scope thereof. Therefore, it is intended that the invention not be limited to the particular embodiment illustrated by the drawings and described in the specification as the best mode presently contemplated for carrying out this invention, but that the invention will include any embodiments falling within the foregoing description and the appended claims.

Moreover, the simple reversal of the location of two components has long been held to be well within the capabilities of one of ordinary skill in the art (i.e., an equivalent). *See, e.g., Vulcan Engineering Co. v. FATA Aluminum Inc.*, 278 F3d 1366, 61 USPQ2d 1545 (Fed. Cir. 2001). Accordingly, Applicant submits that one of ordinary skill in the art would view the as-filed the specification, drawings as providing antecedent basis for the "two embodiments" described by the Examiner. As such, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 1 and 15 under 35 U.S.C. §112, first paragraph.

Claims 14 through 19 and 22 through 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner

states that Claim 11, the base claim from which Claims 14 through 19 and 22 through 26 depend, fails to positively recite any critical interrelationship between the base and the carriage. Applicant notes that Claims 14, 15, 21 and 25 have been amended to include the limitations of Claim 11 (and all intervening claims) and now indicate that the carriage is generically “coupled” to the base, and as such, Applicant respectfully submits that the rejection of Claims 14 through 19 and 22 through 26 under 35 U.S.C. §112, second paragraph has been rendered moot and respectfully requests that the Examiner reconsider and withdraw the rejection.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell et al. (U.S. Pat. No. 6,585,017). This rejection is respectfully traversed.

Applicant initially notes that the ‘017 reference utilizes a single step rod (62) that is threaded into the carriage (200) and secured in place by a nut (63). Accordingly, the step rod (62) is fixedly coupled to the carriage and is not normally removed as the removal of the step rod (62) would necessitate that the stop mechanism be recalibrated. Applicant notes, too, that the “Background” section of the ‘017 at column 3, lines 1 through 8 appears to teach away from the removal of an element such as the step rod as it notes that “one twist of the screw will de-calibrate the settings, requiring an operator to repeat the calibration process.”

In contrast to the arrangement of the ‘017 patent, Applicant’s arrangement permits the pin to be removed and replaced without recalibration of the height setting device. In the particular example illustrated in Figure 21a of the above-referenced application, the bushing (902a) and the jam nut (946) are employed to calibrate the height setting mechanism. The pins are employed to increment the height of the height setting mechanism by

predetermined intervals. By way of an example, if the height setting mechanism would normally provide a range of height settings between 1/8 inch and 7/8 inch and the user wanted to set the height at 2 3/8 inches, the user would simply adjust the height setting to “3/8” inch and thread a pin into the bushing with a body (902f) that was 2” long. Calibration of the system is maintained as the pins include an upper datum (902g) (on the bottom of the body 902f) that is abutted against a lower datum (902d) that is formed on the top of the bushing.

Accordingly, Applicant submits that the Examiner has not presented a *prima facie* case of obviousness. Specifically, the Examiner has not presented any suggestion or motivation to modify the device of the '017 patent in the manner described in the above-referenced Office Action. Accordingly, it appears that the Examiner has reconstructed Applicant's invention with the impermissible use of hindsight.

The Federal Circuit has stated that “[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In carrying out the “rigorous application” of the “requirement” that Examiners show proof of a teaching on motivation to combine references, the Federal Circuit has required that Examiners present *an evidentiary basis* for the particular factual findings necessary to support the alleged suggestion, teaching or motivation to combine references.

Importantly, the Federal Circuit has stated that when prior art references can be shown to teach away from a combination, the claimed invention is likely to be non-obvious. In *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1350 (Fed. Cir. 2001), the Federal Circuit discussed this important legal principle:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia A B v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), limited in other grounds by *In re Gartside*, 203 F.3d 1305 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

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Perhaps *McGinley's* best argument to save his claims from prima facie obviousness in the light of *Pratt* and *Morgan* is his contention that those references together teach away from their combination. We have noted elsewhere, as a 'useful general rule,' that references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. *In re Sponnoble*, 45 F.2d 578, 587 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (inoperable modification teaches away)."

*McGinley*, 262 F.3d at 1354.

In view of the above remarks, Applicant submits that the '017 reference does not teach or suggest the use of a height setting device with a plurality of different pins. Moreover, if differently sized pins were to be used with the height setting device of the '017 patents as suggested by the Examiner, the height setting device would need to be recalibrated each time the pins were replaced, thus rendering the height setting device unfit for its intended purpose. Accordingly, Applicant submits that the Examiner has not provided an evidentiary basis for the particular factual findings necessary to support the alleged suggestion or motivation to modify the '017 reference and as such, has not presented a

*prima facie* case of obviousness. As such, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claim 14 under 35 U.S.C. §103(a).

**ALLOWABLE SUBJECT MATTER**

The Examiner states that claim 27 is allowed, that Claim 1 would be allowable if rewritten to overcome the 35 U.S.C. § 112 rejections, and that Claims 2 through 10 and 15 through 19 and 21 through 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.


Applicant respectfully submits that the rejection to Claim 1 under 35 U.S.C. §112 was traversed above and that Claim 1, as well as Claims 2 through 10 which depend from Claim 1, should be in condition for allowance. Applicant notes that Claims 14, 15, 21 and 25 have been rewritten in independent form to include the limitations of the base claim and any intervening claims. Therefore, Claims 14, 15, 21 and 25 should now be in condition for allowance. Applicant notes that Claims 16 through 19 depend from Claim 15, that Claims 22 through 24 depend from Claim 21 and that Claim 26 depends from Claim 25.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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